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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,015	07/16/2003	Isador H. Lieberman	CCF-6387	9116

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EXAMINER

KIM, JOHN

ART UNIT PAPER NUMBER

3733

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/621,015	LIEBERMAN, ISADOR H.	
	Examiner	Art Unit	
	John Kim	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-8,11,14,17,21,24,30,33,34,36,53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) 8,11,14 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,17,21,24,30,33,36,53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3733

DETAILED ACTION

Examiner's Notes

According to amendment dated 2/10/06, the pending claims are 1, 2, 6, 7, 17, 21, 24, 30, 33, 36, 53 and 54. The other claims are either withdrawn or cancelled.

Claim Objections

Claims and 53 are objected to because of the following informalities: Applicant cites "for attaching a first bone to an adjacent bone", where previously applicant cited "to an adjacent second bone." The removal of "second" was not properly noted in the amended claims. This problem also makes the limitations "second bone" lack antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 53 recites the limitations "one bone" or "the bones." There is insufficient antecedent basis for these limitations in the claims. Though the examiner understands what the applicant is stating, the examiner is weary that the lack of antecedent basis would lead to confusion about the limitations. The applicant is reminded when reciting a new limitation into the claims, the limitation begins with the

Art Unit: 3733

words "a" or "an," and all subsequent recitations of the limitation should be begin with the words "the" or "said."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 17, 21, 24, 30, 33, 36, 53, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenman (US Pat. 5728116, cited in IDS).

Rosenman discloses the claimed invention having an apparatus as an anchor with a platform 20, with a surface that is solid and is transverse to the longitudinal axis of the anchor, and a helical spike (50), projecting tangentially from surface with a tip portion (58). It is noted that though Roseman displays only one helical spike, he discloses that the "spiral consists of at least one coil." (col 2:29) Furthermore, bone is a form of connective tissue. It is noted that the invention is in regards to an apparatus or device. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. (See MPEP 2114) In regards to which bones are being attached to the device, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only the subject matter is in fact inherent in the prior art reference. *In re Schering Corp.*,

Art Unit: 3733

339 F.3d 1372, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003). Thus it would be inherent for Rosenman's invention to used to hold the vertebrae and sacrum together.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenman (US Pat. 5728116, cited in IDS) in view of Kapitanov (US Pat 4204541).

Rosenman discloses the claimed invention except for having a sleeve to insert the anchor. Kapitanov discloses a sleeve that is used to introduce a helical anchor. In addition to preventing premature deformation of the anchor, Kapitanov's invention allows for quick and reliable insertion of the anchor (col 2:23-32). It would have been obvious to one skilled in the art at the time the invention was made to construct the invention of Rosenman, including a sleeve in view of Kapitanov in order to prevent premature deformation of the anchor and allowing quick and reliable insertion of the anchor.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 6, 7, 17, 21, 24, 30, 33, and 36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

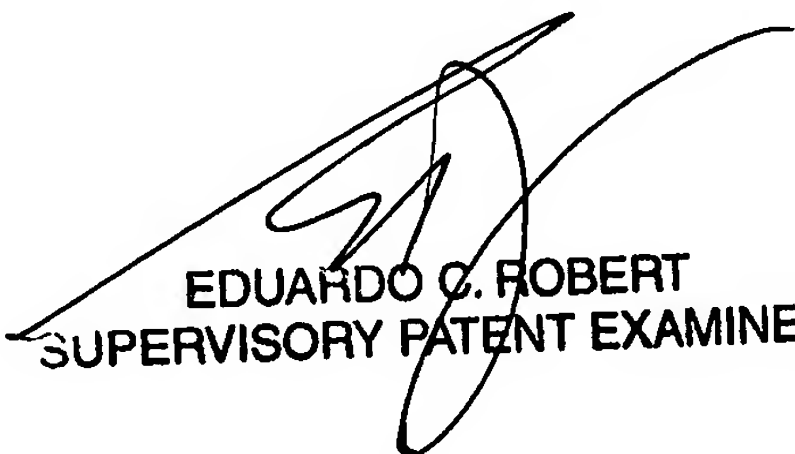
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK (2)


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER